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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/849,344	05/19/2004	Makoto Shiraga	FUJA 21.179	6718

26304 7590 08/11/2006  
KATTEN MUCHIN ROSENMAN LLP  
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NEW YORK, NY 10022-2585

EXAMINER
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BHATTACHARYA, SAM

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 08/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/849,344

Applicant(s)

SHIRAGA ET AL.

Examiner

Sam Bhattacharya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                         |                                                                             |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)     | Paper No(s)/Mail Date. _____                                                |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                             | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The meaning of the phrase “when a call arrives at a called cellular phone from a calling IP phone, a called person manually operates a called IP phone, which is previously registered in said called cellular phone,” as recited in lines 4-6 of claims 1 and 4, is unclear. The specification describes registering a caller’s number in a data storage area of a server, not registering a called IP phone in the cellular phone.

Correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9, as best understood in view of the rejection under 35 U.S.C. 112, second paragraph above, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bicker et al. (US 2005/0096024) in view of Marsh et al. (US 2006/0025141).

Regarding claim 1, Bicker discloses a system and method for forwarding an incoming call from a cellular phone to an IP phone (via a wireless LAN) in a communication system in

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which speech communication is carried out on an Internet Protocol network, including a first step in which, when a call arrives at a called cellular phone from a calling IP phone, a called person operates a called IP phone, to which the incoming call is to be forwarded, whereby a wireless communication is carried out between the called IP phone and the called cellular phone (see FIGS. 1 and 4 and paragraph [0021], lines 1-8), and a second step in which, after the first step, a function built in the called IP phone, to which the incoming call is to be forwarded, automatically communicates with the calling IP phone, so that the incoming call to the called cellular phone is forwarded to the called IP phone to which the incoming call is to be forwarded (see paragraph [0018], lines 16-25).

Bicker fails to disclose a manually operating the IP phone and called phone number that is previously registered in the system. However, in an analogous art, Marsh discloses a communication system having cellular and IP communication where an IP phone is manually operated when a call arrives and a called destination phone number is previously registered in the system prior to being routed to the appropriate area. See FIG. 18 and paragraphs 194-197. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system and method in Bicker by including this feature taught in Marsh for the purpose of allowing the IP phone user to choose whether to answer any incoming call and ensuring that a call intended for the cellular phone can be answered by the IP phone user as well.

Regarding claim 2, Bicker discloses that the communication system is comprised of a storage device in which an identification number of the IP phone is registered, and, in the second step, the function built in the called IP phone, to which the incoming call is forwarded,

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automatically communicates with the storage device and the calling IP phone (see paragraph [0021], lines 8-10).

Regarding claim 3, Bicker discloses that the communication system is comprised of a switching device 138 in which an identification number of the IP phone is registered, and in the second step, the function built in the called IP phone, to which the incoming call is to be forwarded, automatically communicates with the switching device and the calling IP phone. See paragraph [0010], lines 1-9 and paragraph [0020], lines 11-16.

Regarding claim 4, Bicker discloses a method for switching a call from a cellular phone to an IP phone (via a wireless LAN) in a communication system in which a speech communication is carried out on an Internet Protocol network, comprised of a first step in which, when a call arrives at a called cellular phone from a calling IP phone, the called person operates an called IP phone, to which the incoming call is to be forwarded, thereby a wireless communication is carried out between the called IP phone and the called cellular phone (see FIGS. 1 and 4 and paragraph [0021], lines 1-8), a second step in which after the first step, a function built in the called IP phone, to which the incoming call is to be forwarded, automatically communicates with the calling IP phone, a third step in which the function built in the called IP phone which is communicating with the cellular phone disconnects the communication (see paragraphs [0013] and [0014]), a fourth step in which the IP phone which have been communicating with the cellular phone makes a call to the IP phone, to which the incoming call is to be forwarded, thereby the speech communication is switched to the IP phone to which the incoming call is to be forwarded (see paragraph [0018], lines 16-25).

Bicker fails to disclose a manually operating the IP phone and called phone number that is previously registered in the system. However, in an analogous art, Marsh discloses a communication system having cellular and IP communication where an IP phone is manually operated when a call arrives and a called destination phone number is previously registered in the system prior to being routed to the appropriate area. See FIG. 18 and paragraphs 194-197. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system and method in Bicker by including this feature taught in Marsh for the purpose of allowing the IP phone user to choose whether to answer any incoming call and ensuring that a call intended for the cellular phone can be answered by the IP phone user as well.

Claim 5 incorporates the limitations of claims 2 and 4, and is therefore rejected for the same reasons as claims 2 and 4.

Regarding claim 6, Bicker discloses that, in the fourth step, when the communication is switched from the cellular phone to the IP phone, to which the incoming call is to be forwarded, the person who received the call can recognize the switching by a ringtone of the forwarded IP phone (see paragraph [0012]).

Claim 7 incorporates the limitations of claims 5 and 6, and is therefore rejected for the same reasons as claims 5 and 6.

Claim 8 incorporates the limitations of claims 3 and 4, and is therefore rejected for the same reasons as claims 3 and 4.

Claim 9 incorporates the limitations of claims 6 and 8, and is therefore rejected for the same reasons as claims 6 and 8.

*Response to Arguments*

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

*Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Bhattacharya whose telephone number is (571) 272-7917. The examiner can normally be reached on Weekdays, 9-6, with first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sb

  
GEORGE ENG  
SUPERVISORY PATENT EXAMINER